

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q76021

Naoto OSHIMA, et al.

Appln. No.: 10/608,234

Group Art Unit: 1752

Confirmation No.: 1745

Examiner: Hoa Van Le

Filed: June 30, 2003

For: SILVER HALIDE PHOTSENSITIVE MATERIAL FOR COLOR-PHOTOGRAPHY  
AND IMAGE FORMATION METHOD USING THE SAME

**RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The following elections are in reply to the Restriction and Election of Species Requirement dated January 14, 2004, in which the Examiner set forth a one-month period for response, making a response timely if filed on or before February 17, 2004 (February 14, 2004 being a Saturday and February 16, 2004 being a holiday).

In Paragraph D of the Office Action, the Examiner set forth a restriction requirement. In response, Applicants elect Group IV, claims 27-31.

The election is with traverse. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, event though it includes claims to distinct or independent inventions. Note MPEP §803. Applicants respectfully submit that Group III, claims 22-26, should be examined with Group IV, claims 27-31, in view of the similar claimed features. The features of (1) time length for subjecting the exposed silver halide color photosensitive material to color development, (2) time length for completing the color

development, (3) photographic layer constitution, and (4) specific average spherical equivalent diameter of the silver halide particles in the silver halide emulsion layer that contains the yellow dye-forming coupler are recited in claim 22 (an image forming method) and are recited in claim 27 (a silver halide color photosensitive material). Therefore, it is not an undue burden on the Examiner to search the Groups III and IV together and restriction is unwarranted and improper.

Further, Applicants respectfully submit that Group II, claims 12-21, should be examined with Group I, claims 1-11, in view of the similar claimed features. The features of (1) time length for subjecting the exposed silver halide color photosensitive material to color development, (2) photographic layer constitution, (3) silver halide content, and (4) metal complex represented by Formulae (I) or (II) are recited in claim 12 (an image forming method) and are recited in claim 1 (a silver halide color photosensitive material). Since both Groups IV and I relate to silver halide color photosensitive materials, and have similar features of (1) time length for subjecting the exposed silver halide color photosensitive material to color development, (2) photograph constitution layer, and (3) silver halide content, Applicants respectfully submit that Groups IV and I (and Groups III and II) should be examined at the same time in the present application. Therefore, it is not an undue burden on the Examiner to search all of the claims together and restriction is unwarranted and improper.

In Paragraph C of the Office Action, the Examiner set forth an election of species requirement. In response, Applicants elect Formula (I) and the specie disclosed at page 18, line 10, of the present specification ( $[\text{IrCl}_5(5\text{-methylthiazole})]^{2-}$ ). Claims 1-3, 5-7, 9-14, 16-18, 20 and 21 read on the elected specie.

The election is with traverse. One of the criteria for a proper election of species requirement is that there must be a serious burden on the Examiner if restriction is not required. See MPEP §803, §806.04(a)-(j), §808.01(a) and §808.02. It is respectfully submitted that the claimed imaging forming methods and silver halide color photosensitive materials, and the general formulae (I) and (II), do not represent an unreasonable number of species to examine in a single application. Further, if the members of a Markush group are sufficiently few in number, or are so closely related that a search and examination of the entire class can be made without serious burden, the Examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case, the Examiner will not require restriction. See MPEP §803.02. It is respectfully submitted that there is no serious burden on the Examiner to examine Applicants' invention as claimed.

The elections are made without prejudice to the filing of Divisional Applications.

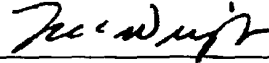
#### **Summary of Examiner Interview**

On October 24, 2003, Examiner Le initiated an interview with the undersigned Applicants' representative to request an oral election in response to a restriction requirement and an election of species requirement. The written restriction requirement is substantially the same as the oral restriction requirement, except for the grouping of claim 10 in Group I and in Group II. On November 5, 2003, the undersigned Applicants' representative responded orally with Applicants' elections.

Response to Restriction and Election of Species Requirements  
Appln. No.: 10/608,234

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: February 17, 2004